

REMARKS

Pursuant to the present amendment, claims 1, 7, 10, 15, 21, 24 and 27 have been amended and claims 4, 5, 8, 17, 20, 23 and 29-42 have been canceled. Thus, claims 1-3, 6, 7, 9-16, 18, 19, 21, 22 and 24-28 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested in view of the amendments and arguments set forth herein.

Pursuant to the present amendment, claims 29-42 have been canceled as they are directed to a non-elected invention that was the subject of a previous restriction requirement. Applicants specifically reserve the right to pursue the subject matter defined by the canceled claims in a later filed application should they so desire.

In the Office Action, claims 1-13 and 15-27 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by O'Neil (U.S. Patent No. 6,306,172). Claims 14 and 28 were rejected under 35 U.S.C. § 103 as allegedly being obvious over O'Neil in view of Smith (U.S. Patent No. 5,108,442). Applicants respectfully traverse the Examiner's rejections.

As the Examiner well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency requires that the asserted proposition necessarily flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should

have, or would have been used as the claimed invention. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Oelrich*, at 326, quoting *Hansgirk v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Skinner*, at 1789, citing *Oelrich*. Where anticipation is found through inherency, the Office’s burden of establishing prima facie anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Skinner* at 1789.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

Pursuant to the present amendment, independent claims 1 and 15 have been amended to recite that the claimed device comprises at least one removable pin (claim 1) or removable means (claim 15), wherein, when installed, a first portion of the pin or removable means is configured to engage an opening formed in a perimeter side surface of the base plate **and** a second portion of the pin ore removable means is configured to engage an opening formed in a perimeter side surface of the insert to thereby prevent relative rotation between the insert and the base plate. In view of these amendments, it is respectfully submitted that all pending claims are in condition for immediate allowance.

Independent claims 1 and 15 have been amended to make it even more clear that the openings in the insert and base plate are formed in the perimeter side surfaces of the insert and the base plate. This illustrative embodiment of the present invention is depicted in, for example, Figures 10A-10D and the associated discussion of those figures in the specification. As noted in the specification, positioning the removable pin or removable means in the perimeter side surface provides a surgeon with ready access to such a pin or removable means. Specification, p. 10, ll. 8-17.

It is respectfully submitted that such a structure is not remotely suggested by O'Neil. As understood by the undersigned, in all embodiments disclosed therein, the pin or structure used to prevent rotation of the insert relative to the base plate is positioned, in one form or another, in openings formed in the bottom surface of the insert and the top surface of the base plate. At no point does O'Neil suggest or disclose the location of a removable pin or removable means that engages openings formed in perimeter side surfaces of the insert and the base plate as now set forth in the pending claims. Thus, all claims are believed to be in condition for immediate allowance.

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. It is respectfully submitted that any attempt to assert that the invention defined by amended independent claims 1 and 15 would have been obvious in view of the prior art of record

constitutes an impermissible use of hindsight using Applicants' disclosure as a roadmap. "Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Teleflex v. KSR Intern. Co.*, 119 Fed. Appx. 282 (Fed. Cir. 2005) (unpublished) (citations omitted).

For at least the aforementioned reasons, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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Date: October 31, 2006

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